

## REMARKS

The Applicants acknowledge the Examiner's comprehensive Office Action with appreciation. Claims 1-32 and 39-55 remain pending in the application; however, Claims 8-11, 23-25, 27-32, 42-43, and 45-55 have been withdrawn from consideration as a result of the previously issued Restriction Requirement. The Office maintains this Restriction Requirement and makes it Final. The Office raises rejections under 35 USC § 112, second paragraph, as well as prior art rejections under 35 USC § 102 and 35 USC § 103. The Office also raises objections as to form.

With respect to the Restriction Requirement, the Office reiterates its position that **Group I**, directed to aqueous based compositions comprising an active species (i.e., a compound of formula (I)) and **Group II**, directed to aqueous based compositions comprising an active species (i.e., a compound of formula (I) as well as additional components) lack unity of invention. It is the position of the Office that the previous amendment, in which the claims were limited to preservative free compositions and neramexane was selected as the active species, does not overcome the unity objection since preservative free compositions comprising 1-aminocyclohexane derivatives do not define a contribution over the prior art, as evidenced by the prior art rejections issued in the instant Office Action.

With the instant Amendment, the claims have been limited to preservative free compositions comprising neramexane. Thus, the Applicants respectfully submit that the instant invention, as amended, involves unity as the "special common technical feature" is a preservative free aqueous-based neramexane composition. The Applicants respectfully request that the species claims directed to neramexane compositions (i.e., Claims 45 and 48-55) be included for examination in the instant application.

The Office states the instant application appears to claim subject matter disclosed in prior Application No. 60/517,981 and that, in order to properly claim the benefit to an earlier filed application, the required reference to the priority application "must be included in an application data sheet or the specification must contain or be

amended to contain such reference in the first sentence following the title." The Applicants respectfully submit that the priority claim to US Provisional Application No. 60/517,981 was acknowledged on the Official Filing Receipt issued in the instant application. Moreover, with the instant Response, the Applicants provide an Application Data Sheet which contains the required reference to the earlier filed PCT application (PCT/US2004/037026) as well as the US provisional application (Serial No. 60/517,981), thereby perfecting the priority claim, which claim was made upon filing.

The Office raises an objection to Claims 17-22 based on the phrase "optionally comprising" recited in Claims 17 and 20. The Office notes that, since Claims 17 and 20 recite "optional" components, these claims do not properly limit Claim 1. The Office further states that these claims have been examined to the extent that they read on the elected invention.

Claim 22 is also rejected for indefiniteness under 35 USC § 112, second paragraph. It is the position of the Office that, since Claim 20 "optionally" comprises a solubilizer and Claim 22 recites "wherein the glycerin is present ...", it is not clear whether the glycerin of the composition recited in Claim 22 is required or optionally present.

With the instant Amendment, the phrase "optionally comprising" recited in Claims 17 and 20 has been replaced with "further comprising" to clarify the meaning of Claims 17-22. Withdrawal of the objection is respectfully requested.

The Office objects to Claim 44, stating that there is no period at the end of the claim but that a period appears after a and b. Claim 44 is also rejected for indefiniteness under 35 USC § 112, second paragraph. It is the position of the Office that since there is no conjunction (i.e., "and") between components a and b, the meaning is not clear. With the instant Amendment, Claim 44 has been amended to insert "and" between components a and b. The Applicants also submit that there is a period at the end of Claim 44 and that one skilled in the art would recognize what is meant by this claim. Withdrawal of the objection is respectfully requested.

Claims 1-3, 6-7, 12, 14-22, and 39-40 are rejected under 35 USC § 102(b) as being anticipated by the disclosure of Parsons, et al. (WO 01/98253). It is the position of the Office that Parsons, et al. disclose 1-aminoalkylcyclohexane compounds, which compounds include the elected compound neramexane, and that the reference further discloses liquid compositions comprising the disclosed compounds, which compositions anticipate the instant compositions.

As noted above, the claims have been limited to preservative-free compositions comprising neramexane and pharmaceutically acceptable salts thereof with the instant Amendment. The Applicants respectfully submit that Parsons, et al. do not specifically disclose **preservative-free** compositions comprising neramexane or a pharmaceutically acceptable salt thereof. Therefore, the generic disclosure of this cited reference does not anticipate the instantly claimed compositions, as amended. Reconsideration and withdrawal of the anticipation rejection under 35 USC § 102(b) is respectfully requested.

Claims 1, 4-5, and 39-41 are rejected for obviousness under 35 USC § 103(a) based on the disclosure of the above-mentioned Parsons, et al. reference. The Office states that, although Parsons, et al. do not teach aqueous neramexane compositions of about 4 mg/mL or 5 mg/mL as recited in instant Claims 4-5, the reference discloses specific concentrations of 2, 10, and 20 mg/mL. It is the position of the Office that it would have been obvious for one skilled in the art to prepare solutions with intermediate concentrations based on the disclosure of the concentrations in the reference and that such compositions would have been achievable through routine optimization.

Claims 1, 13, 26, and 44 are further rejected for obviousness under 35 USC § 103(a) based on the disclosure of Parsons, et al. in view of Gupta, et al. (US Published Application No. 2005/0014743). It is the position of the Office that Parsons, et al. teach that the 1-aminocyclohexanes of the instantly claimed compositions are NMDA antagonists useful in treating CNS disorders. The Office states that Parsons, et al. do not disclose neramexane mesylate nor aqueous solutions comprising a second active agent that is not a compound of instant formula

(I). It is the further position of the Office that Gupta, et al. disclose that various salts of NMDA receptor antagonists (including neramexane mesylate) may be used for the treatment of depression and other mood disorders and that the use of neramexane mesylate in combination with another antidepressant (i.e., an SSRI) is also disclosed. The Office concludes that it would have been obvious for one skilled in the art to replace neramexane in the aqueous compositions disclosed in Parsons, et al. with neramexane mesylate to arrive at the compositions of instant Claims 13 and 26 or to add an SSRI (as disclosed in Gupta, et al.) or another CNS-effective compound to arrive at the combinations recited in instant Claim 26.

The Applicants respectfully submit that there is no teaching in the Parsons, et al. disclosure to suggest the surprising/unexpected anti-microbial properties associated with neramexane, which properties are disclosed in the instant specification, for example, at pages 25-27. The specification also discloses (at page 16) that such properties provide advantages over conventional formulations in terms of tolerability and safety since the microbial quality of the composition is provided by the active ingredient itself. Therefore, in view of the surprising and unexpected effects associated with the instantly claimed compositions, the disclosure of the Parsons, et al. reference, alone or in combination with the disclosure of the Gupta, et al. reference does not render the instantly claimed **preservative free** compositions obvious. Reconsideration and withdrawal of the obviousness rejections under 35 USC § 103(a) is respectfully requested.

Finally, the Applicants note that the Examiner has not considered the International Search Report (ISR) which was included with the Information Disclosure Statement (IDS) submitted with the filing papers of the instant application. The Office states that this document does not have a publication date. The Applicants respectfully submit that the ISR is publicly available at the WIPO website, and that, therefore this document is, in fact, a "publication" in the international equivalent of the instant application. A copy of the listing of this reference from the WIPO website is enclosed. The Applicants also submit a new Form PTO-1449 listing the previously submitted International Search Report (ISR) and respectfully request that the Office consider this previously submitted reference.

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Accordingly, entry of present amendment, acknowledgment of the valid priority claim, entry and acknowledgment of the IDS, reconsideration of all grounds of objection and rejection, withdrawal thereof, and passage of this application to issue are all hereby respectfully solicited.

It should be apparent that the undersigned agent has made an earnest effort to place this application into condition for immediate allowance. If she can be of assistance to the Examiner in the elimination of any possibly-outstanding insignificant impediment to an immediate allowance, the Examiner is respectfully invited to call her at her below-listed number for such purpose.

Allowance is solicited.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

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Enclosure: Application Data Sheet; Form PTO-1449 and Accompanying Reference; Listing of Claims; and Postal Card Receipt

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**THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FURTHER OR ADDITIONAL FEES WHICH MAY BE REQUIRED (DUE TO OMISSION, DEFICIENCY, OR OTHERWISE), OR TO CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 08,3220.**